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SCHIEF HARDIN, LLP PATENT DEPARTMENT 6600 SEARS TOWER CHICAGO, IL 60606-6473			EXAMINER CAMPEN, KELLY SCAGGS	
			ART UNIT 3691	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

## Application No.

09/980,643

## Applicant(s)

SPIRA ET AL.

## Examiner

KELLY CAMPEN

## Art Unit

3691

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 12 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-133 is/are pending in the application.
- 4a) Of the above claim(s) 51-133 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-50 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/88)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

## **DETAILED ACTION**

***The following is in response to the amendments and arguments dated 11/12/2008. Claims 1-133 are pending, claims 51-133 have been withdrawn.***

### ***Specification***

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

### ***Claim Objections***

Claims 1-50 are objected to because of the following informalities: the claims are generally inclusive of vague language such as (but not limited to) in claim 2, "same criteria", claim 5, " same course of action" . Appropriate correction is required.

Specifically as to claim 25, the claim appears to have a typographical error in that it does not refer to a previous claim yet it appears to be a dependent claim. As such, it should be corrected. For examination purposes, it will be interpreted as being depending from claim 1.

Specifically as to claim 48, including steps a, b, c, and d is confusing as it depends from claim 1 which in turn includes steps a, b, and c.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

Art Unit: 3691

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-50 are rejected as failing to define the invention in the manner required by 35 U.S.C. 112, second paragraph.

The claim(s) are narrative in form and replete with indefinite and functional or operational language. The structure which goes to make up the device must be clearly and positively specified. The structure must be organized and correlated in such a manner as to present a complete operative device. The claim(s) must be in one sentence form only. Note the format of the claims in the patent(s) cited.

Claims 1-50 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Specifically as to claim 1, it is unclear if the claim is directed to an apparatus (customer related services) or a method. It appears to be directed to the apparatus but there are no clear means but if it is a method, it does not state or claim a method per se, but a vague reference to steps being performed, continuously.

**For examination purposes, the claim will be understood to be directed to the method.**

Specifically as to claims 2-50, it appears the claims are directed to an apparatus yet the claims provide further steps in a method. For examination purposes, the claims will be examined as method claims.

Specifically as to claim 5, it is unclear what the metes and bounds of the claim are as the terms "a same course of action" what course of action?

**In light of the extensive 35 USC 112 second paragraph rejections, the claims will be interpreted as best may be understood for the purposes of a prior art rejection.**

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-50 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1-50 recite a process comprising the steps of providing, utilizing, and consulting. Based on Supreme Court precedent, a proper process must be tied to another statutory class or transform underlying subject matter to a different state or thing (*Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876)). Since neither of these requirements is met by the claim, the method is not considered a patent eligible process under 35 U.S.C. 101. To qualify as a statutory process, the claim should positively recite the other statutory class to which it is tied, for example by identifying the apparatus that accomplished the method steps or positively reciting the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-50 are rejected under 35 U.S.C. 102(b) as being anticipated by Doyle (US 5233513).

Specifically as to claim 1, Doyle discloses a customer related technical services for obtaining an optimal financial result of a production plant by continuously applying the steps of: a) providing a process description; b) utilizing connected software tools and hardware tools; and c) consulting an empirical database of experience (see abstract, figures 1A-3D with associated description, col 7-col 9).

Specifically as to claim 2, the step of providing a process description is performed a plurality of times worldwide according to a same criteria for each said process description (see col 7-9, col 13 line 1 to col 16 line 5).

Specifically as to claim 3, utilizing homogenous forms of marketing/acquisition, standard basic contract forms, standard offer management, mobilization, operation and demobilization (see figures 1A-3D with associated description and col 13 line 1 to col 16 line 5).

Specifically as to claim 4, performing the according to defaults of a manual(see figures 1A-3D with associated description and col 13 line 1 to col 16 line 5).

Specifically as to claim 5, repeating steps a), b) and c) multiple times for different locations; utilizing a same course of action for steps a), b) and c) for each location

Art Unit: 3691

worldwide ; providing best practice sharing with respect to internationally comparable standards; and introducing continuous improvement processes on a basis that is always the same (see figures 1A-3D with associated description and col 13 line 1 to col 16 line 5 and col 92 lines 17-65).

Specifically as to claim 6, describing internal and external processes in a manual, the internal processes run on a customer plant (see figures 1A-3D with associated description and col 13 line 1 to col 16 line 5 and col 92 lines 17-65 and col 125-128).

Specifically as to claim 7, the manual is in writing in at least one of text form and diagram form plant (see figures 1A-3D with associated description and col 13 line 1 to col 16 line 5 and col 92 lines 17-65 and col 125-128).

Specifically as to claim 8, wherein the manual is in a form readable by a personal computer and which can be printed plant (see figures 1A-3D with associated description and col 13 line 1 to col 16 line 5 and col 92 lines 17-65 and col 125-128).

Specifically as to claim 9, wherein the manual is on a CD-ROM plant (see figures 1A-3D with associated description and col 13 line 1 to col 16 line 5 and col 92 lines 17-65 and col 125 to col 128, col 213).

Specifically as to claim 10, wherein the manual is on the World Wide Web (see col 219 to col 222 and col 125 to col 128, col 213).

Specifically as to claim 11, wherein the manual is in an encoded form that can only be retrieved by a password (see col 219 to col 222 and col 125 to col 128, col 213).

Specifically as to claim 12, wherein the manual is embedded into a virtual scene and includes simulation possibilities (see col 219 to col 222 and col 125 to col 128, col 213).

Art Unit: 3691

Specifically as to claim 13, wherein the manual has a portal with selection possibilities for different technical services in its form that can be executed on the PC (see figures 1A-3D with associated description and col 13 line 1 to col 16 line 5 and col 92 lines 17-65 and col 125 to col 128, col 213).

Specifically as to claim 14, subjecting content of the manual to a dynamic process which derives from an integration of a dynamically growing experience database into the manual (see figures 1A-3D with associated description and col 13 line 1 to col 16 line 5 and col 92 lines 17-65).

Specifically as to claim 15, wherein the manual takes product-specific bits of information and plant-specific bits of information from experience databases from worldwide plants having a same production target and the same production methods (see figures 1A-3D with associated description and col 13 line 1 to col 16 line 5).

Specifically as to claim 16, wherein technical developments as well as methodical developments are a part of the experience database (see figures 1A-3D with associated description and col 13 line 1 to col 16 line 5 and col 92 lines 17-65 and col 125 to col 128, col 213).

Specifically as to claim 17, wherein the manual contains a work flow for maintenance teams (see col 7-9, col 13 line 1 to col 16 line 5).

Specifically as to claim 18, wherein the manual suggests method groups and methods as work instructions dependent on the work flow (see figures 1A-3D with associated description and col 13 line 1 to col 16 line 5 and col 92 lines 17-65).

Specifically as to claim 19, wherein the manual organizes a consideration and the following implementation of the workers utilizing centers of excellence, said centers of



Art Unit: 3691

excellence having special knowledge (see figures 1A-3D with associated description and col 13 line 1 to col 16 line 5 and col 92 lines 17-65 and col 125 to col 128, col 213).

Specifically as to claim 20, wherein the maintenance work is carried out by local units supported by the centers of excellence (see figures 1A-3D with associated description and col 13 line 1 to col 16 line 5).

Specifically as to claim 21, wherein the centers of excellence are distributed and networked such that it is always possible to access resources (see figures 1A-3D with associated description and col 13 line 1 to col 16 line 5 and col 92 lines 17-65).

Specifically as to claim 22, wherein the resources are experts (see figures 1A-3D with associated description and col 13 line 1 to col 16 line 5).

Specifically as to claim 23, wherein the experts can be reached 24 hours a day (see figures 1A-3D with associated description and col 13 line 1 to col 16 line 5 and col 92 lines 17-65 and col 125 to col 128, col 213).

Specifically as to claim 24, wherein said software tools are available via the World Wide Web (see col 7-9, col 13 line 1 to col 16 line 5).

Specifically as to claim 25, providing a system for implementing services with individual components which are obtainable on the market, said individual components being connected to a web-based knowledge-based database that continuously works with experience values (see figures 1A-3D with associated description and col 13 line 1 to col 16 line 5 and col 92 lines 17-65 and col 125 to col 128, col 213).

Specifically as to claim 26, wherein the individual components are software tools (see figures 1A-3D with associated description and col 13 line 1 to col 16 line 5 and col 92 lines 17-65).

Art Unit: 3691

Specifically as to claim 27, utilizing external data and external tools for supplementing (see col 7-9, col 13 line 1 to col 16 line 5).

Specifically as to claim 28, transmitting data in an encoded fashion between the centers of excellence and the local units (see figures 1A-3D with associated description and col 13 line 1 to col 16 line 5).

Specifically as to claim 29, improving standard software utilizing originally present experience data and improved experience data, said standard software being supplemented by experiences present in the database, utilizing worldwide knowledge therefor (see figures 1A-3D with associated description and col 13 line 1 to col 16 line 5 and col 92 lines 17-65 and col 125 to col 128, col 213).

Specifically as to claim 30, monitoring a condition of the plant utilizing remote expert centers (see figures 1A-3D with associated description and col 13 line 1 to col 16 line 5 and col 92 lines 17-65).

Specifically as to claim 31, providing an application service host that is one of centrally arranged and arranged remotely connected by the Internet, distribution and data forwarding ensues worldwide (see col 7-9, col 13 line 1 to col 16 line 5).

Specifically as to claim 32, wherein the application service host is isolated from the individual customer programs and has fire walls between the customers, so that the customer data cannot be viewed externally (see figures 1A-3D with associated description and col 13 line 1 to col 16 line 5 and col 92 lines 17-65 and col 125 to col 128, col 213).

Art Unit: 3691

Specifically as to claim 33, collecting data from all customers and OEM's in an anonymous fashion using a central database (see figures 1A-3D with associated description and col 13 line 1 to col 16 line 5).

Specifically as to claim 34, providing non-confidential portions of said data collected from the customers available via the World Web (see col 7-9, col 13 line 1 to col 16 line 5).

Specifically as to claim 35, wherein the central database is on distributed servers (see figures 1A-3D with associated description and col 13 line 1 to col 16 line 5).

Specifically as to claim 36, selecting databases by a portal (see figures 1A-3D with associated description and col 13 line 1 to col 16 line 5 and col 92 lines 17-65 and col 125 to col 128, col 213).

Specifically as to claim 37, wherein the step of selecting is by menu prompting.

Specifically as to claim 38, wherein the experience database represents reference data from a provider's projects and customer projects, OEM data, industrial standard data, project experience data from other projects, standard maintenance, and standard operating plans (see figures 1A-3D with associated description and col 13 line 1 to col 16 line 5 and col 92 lines 17-65).

Specifically as to claim 39, modifying OEM defaults and utilizing modified defaults when the OEM defaults are not advantageous for the customer (see figures 1A-3D with associated description and col 13 line 1 to col 16 line 5).

Specifically as to claim 40, wherein said modified defaults are maintenance intervals (see figures 1A-3D with associated description and col 13 line 1 to col 16 line 5 and col 92 lines 17-65).

Art Unit: 3691

Specifically as to claim 41, internationally acquiring experience data; organizing said experience data in a business-specific and system-specific manner; and using key performance data and key performance indicators (see figures 1A-3D with associated description and col 13 line 1 to col 16 line 5 and col 92 lines 17-65 and col 125 to col 128, col 213).

Specifically as to claim 42, providing feedback loops for performing the services with a start at the original plant condition data (see col 7-9, col 13 line 1 to col 16 line 5).

Specifically as to claim 43, wherein plant start data serves to introduce initial measures (see figures 1A-3D with associated description and col 13 line 1 to col 16 line 5).

Specifically as to claim 44, within a framework of measures how the plant reacts to the initial measures; and deriving further measures for improvement from the learning step (see figures 1A-3D with associated description and col 13 line 1 to col 16 line 5 and col 92 lines 17-65 and col 125 to col 128, col 213).

Specifically as to claim 45, entering an effect of measures into the experience database, as well as key performance data (see figures 1A-3D with associated description and col 13 line 1 to col 16 line 5).

Specifically as to claim 46, introducing a request for changing the procedure which is business-specific into the manual (see figures 1A-3D with associated description and col 13 line 1 to col 16 line 5 and col 92 lines 17-65).

Specifically as to claim 47, introducing modified methods and tools into the manual due to the necessary changes in the procedure (see col 7-9, col 13 line 1 to col 16 line 5).

Specifically as to claim 48, improving services by a) a database, b) a manual, c) local project experiences, which are directly realized, and d) an improvement of the software tools and hardware tools (see figures 1A-3D with associated description and col 13 line 1 to col 16 line 5 and col 92 lines 17-65 and col 125 to col 128, col 213).

Specifically as to claim 49, wherein said software tools are provided by access through the World Wide Web (see col 7-9, col 13 line 1 to col 16 line 5).

Specifically as to claim 50, providing that tools for improvement permanently communicate with the database (see figures 1A-3D with associated description and col 13 line 1 to col 16 line 5 and col 92 lines 17-65).

#### ***Examiner's Note***

Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

#### ***Response to Arguments***

Applicant's arguments with respect to claims 1-50 have been considered but are moot in view of the new ground(s) of rejection.

Art Unit: 3691

Applicant's arguments filed 11/12/2008 have been fully considered but they are not persuasive. Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.

As a courtesy, Applicant is reminded to be fully responsive to the above office action by addressing each outstanding objection and rejection whether applicant agrees or disagrees.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KELLY CAMPEN whose telephone number is (571)272-6740. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3691

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Kelly Campen  
Primary Examiner  
Art Unit 3691

/Kelly Campen/  
Primary Examiner, Art Unit 3691